

Serial No.: 09/295,864

Attorney Docket No: MCS-003-98

REMARKS

In response to the final Office Action dated June 19, 2006, claims 1, 12, 25, and 32 have been amended. Therefore, claims 1-32 remain in the case. The Applicants respectfully request that this amendment be entered under 37 C.F.R. 1.116 to place the above-referenced application in condition for allowance or, alternatively, in better condition for appeal. Reexamination and reconsideration of the amended application are requested.

Allowable Subject Matter

At item numbers 14 and 15 of the final Office Action, the Examiner suggested potentially allowable subject matter. In a telephonic interview with Examiner Champagne on July 14, 2006 seeking further clarification, Examiner Champagne pointed the undersigned to page 19 of the specification, where another application is incorporated by reference. Namely, "described in co-pending U.S. Application Serial No. 09/157,018, filed on September 18, 1998 and entitled "A SYSTEM AND METHOD FOR DYNAMICALLY ADJUSTING DATA VALUES AND ENFORCING VALID COMBINATIONS OF THE DATA IN RESPONSE TO REMOTE USER INPUT" which is incorporated by reference herein." This is now patent 6,803,926. In particular, Examiner Champagne noted that the material at col. 9, lines 19-23 of the '926 patent contain potentially patentable subject matter.

Examiner Champagne also provided a proposed amendment to claim 1, while cautioning that "a search of the prior art would be required to determine if the claims so amended are patentable" and that "[A]n allowance conference would also have to be convened to review and accept the Primary Examiner's basis for allowance." In addition, Examiner Champagne noted that the '926 patent is not prior art.

In light of these facts, the Applicants have amended independent claims 1, 12, 25, and 32 as suggested by the Examiner. Thus, as explained below, the Applicants respectfully believe that the Applicants' claimed invention is patentable over the cited art.

Section 103(a) Rejections

The final Office Action of June 19, 2006 rejected claims 1-9, 12-22, 25-28, 30 and

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32 of the subject application under 35 USC §103(a) as being obvious over Bull et al. (US Patent No. 5,901,287) in view of Gifford (US Patent No. 4,845,658) and Moss et al. (US Patent No. 5,485,370).

The final Office Action also rejected claims 10, 11, 23, 24, and 29 under 35 USC §103(a) as being obvious over Bull et al. in view of Gifford and Moss et al. and further in view of Wong.

The final Office Action also rejected claim 31 under 35 USC §103(a) as being obvious over Bull et al. in view of Gifford and Moss et al. and further in view of Chapin, Jr.

In response, the Applicants respectfully traverse these rejections based on the amendments to claims 1, 12, 25, and 32. The Applicants submit that the cited references lack a feature of the Applicants' claimed invention. In particular, the cited references do not disclose, either explicitly or implicitly, the material claimed feature of preventing the user from encountering sub-item or dependency conflicts for both data entered into the client by the user, wherein preventing further comprises not offering sub-items unrelated to requested data and automatically selecting other sub-items as a particular conflicting sub-item is requested by the user. Further, the cited references fail to appreciate the advantages of this claimed feature. In addition, there is no technical suggestion or motivation disclosed in the cited references to define this claimed feature. Thus, the Applicants submit that the cited references cannot make obvious the Applicants' claimed feature discussed above.

To make a prima facie showing of obviousness, all of the claimed features of an Applicants' invention must be considered, especially when they are missing from the prior art. If a claimed feature is not disclosed in the prior art and has advantages not appreciated by the prior art, then no prima facie showing of obviousness has been made. The Federal Circuit Court has held that it was an error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

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1988). Moreover, as stated in the MPEP, if a prior art reference does not disclose, suggest or provide any motivation for at least one claimed feature of an Applicants' invention, then a prima facie case of obviousness has not been established (MPEP § 2142).

Amended independent Claims 1, 12, 25, and 32

Amended independent claims 1, 12, 25, and 32 of the Applicants' claimed invention includes preventing the user from encountering sub-item or dependency conflicts for both data entered into the client by the user. This preventing also includes not offering sub-items unrelated to requested data, and automatically selecting other sub-items as a particular conflicting sub-item is requested by the user.

The combination of cited references fails to teach this claimed feature. Moreover, the combination of cited references also fails to appreciate or recognize the advantages of the Applicants' claimed feature. In particular, the invention prevents "the user from creating sub-item combination conflicts and to resolve any potential conflicts during user adjustment of the sub-items. An example of this is if a user enters incorrect car mileage information, such as alpha-characters instead of numerical characters" (specification, page 29, lines 11-16). The combination of cited references fails to discuss or appreciate these advantages of the Applicants' claimed feature.

The Applicants, therefore, submit that obviousness cannot be established since the combination of cited references fails to teach, disclose, suggest or provide any motivation for the Applicants' claimed feature of preventing the user from encountering sub-item or dependency conflicts for both data entered into the client by the user, wherein preventing further comprises not offering sub-items unrelated to requested data and automatically selecting other sub-items as a particular conflicting sub-item is requested by the user. In addition to explicitly lacking this feature, the combination of cited references also fails to implicitly disclose, suggest, or provide motivation for this feature. Further, the combination of the cited references fails to appreciate advantages of this claimed feature.

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Therefore, as set forth in *In re Fine* and MPEP § 2142, the combination of cited references does not render the Applicants' claimed invention obvious because each of the references is missing the material feature of the Applicants' claimed invention of preventing the user from encountering sub-item or dependency conflicts for both data entered into the client by the user, wherein preventing further comprises not offering sub-items unrelated to requested data and automatically selecting other sub-items as a particular conflicting sub-item is requested by the user. Consequently, because a prima facie case of obviousness cannot be established due to the lack of "some teaching, suggestion, or incentive supporting the combination", the rejection must be withdrawn. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); MPEP 2143.01.

Accordingly, the Applicants respectfully submit that independent claims 1, 12, 25, and 32 are patentable under 35 U.S.C. § 103(a) over Bull et al. in view of Gifford, Moss et al. Wong, and Chapin, Jr. based on the amendments to claims 1, 12, 25 and 32 and the legal and technical arguments set forth above and below. Moreover, claims 2-11 depend from amended independent claim 1, claims 13-24 depend from amended independent claim 12, and claims 26-31 depend from amended independent claim 25, and are also nonobvious over the cited references (MPEP § 2143.03). The Applicants, therefore, respectfully request reexamination, reconsideration and withdrawal of the rejection of claims 1-32.

Conclusion

Because the Applicants' claimed invention as amended includes features neither taught, disclosed nor suggested by the art cited in the Office Action, the Applicants respectfully submit that the rejections of claims 1-32 has been overcome.

The Applicants, therefore, submit that claims 1-32 of the subject application are in condition for immediate allowance. The Examiner, therefore, is respectfully requested to withdraw the outstanding rejections of the claims and to pass all of the claims of this application to issue.